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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/338,209	06/22/1999	MARSHALL MEDOFF	08895/006001	1113

7590 05/24/2002

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EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

1/D

DATE MAILED: 05/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/338,209

Applicant(s)

MEDOFF ET AL.

Examiner

Jenna-Leigh Befumo

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-6,8,9 and 12-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7,10 and 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 7, 10, and 11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
2. The phrase “internal fibers are substantially exposed” in claim 7 is indefinite. As set forth in section 4 of the previous Office Action it is unclear what is meant by “substantially exposed.” The Applicant argues that based on the Figures in the present application it should be apparent to one in the art what is meant by “substantially exposed.” However, the disclosure fails to define the term “substantially exposed” with respect to the pictures or the amount of shearing the poly-coated paper has undergone. Shredding the poly-coated paper, as shown in Figure 3, would expose a “substantial” amount of fibers. Even though these fibers are only partially exposed the number of fibers exposed is still “substantial”. The Applicant has failed to limit the term “substantially exposed” to define what qualifies as “substantial” and to define what qualifies as “exposed.” Thus, paper which has been shredded to a substantially degree as shown in Figure 3 are considered “substantially exposed.” How many fibers and how much of each fiber needs to be “exposed” to be considered “substantial”? It is suggested that the Applicant define what substantially exposed by defining the size and shape of the final product, i.e., the “texturized fibrous material”, so that the claim does not read on finely shredded pieces of poly-coated paper.

***Election/Restrictions***

3. With respect to the Applicant's arguments with traverse and the request for rejoinder of Group III – VI with Group II when it is found allowable, the Applicant has failed to show the restriction requirements were improper. The Applicant argues that since the final products in Groups III – VI include the limitations of the intermediate product in Group II, the claims in Groups III – VI should be allowable when Group II is found allowable. Since this argument fails to traverse the requirements to the restriction, i.e., present reasons why the restriction is improper, the restriction is final. However, since the intermediate product/final product restriction is a species restriction, when the elected species is found allowable, the next species will be examined. Thus, the final products species will be examined after the intermediate product is found allowable.

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claim 7 stands rejected under 35 U.S.C. 102(b) as being anticipated by Erickson (4,020,212) for the reasons of record.

6. Claim 7 stands rejected under 35 U.S.C. 102(b) as being anticipated by Lamb, Sr. (5,137,668) for the reasons of record.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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8. Claims 10 and 11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson or Lams, Sr. for the reasons of record.

***Response to Arguments***

9. Applicant's arguments filed March 19, 2002, have been fully considered but they are not persuasive. The Applicant argues that Erickson fails to teach the claimed product since the poly-coated paper is cellulosic and Erickson discloses a polyolefin material (Response, pages 2- 3). However, since the Applicant fails to recited the composition of the poly-coated paper in the disclosure or in the claims, the poly-coated paper is not limited to cellulosic materials. As evidenced by Aoki et al. (3,808,091), paper can be made from synthetic materials such as polyolefins. Thus, since the Applicant failed to define the term "poly-coated paper" it was interpreted in its broadest sense which would include synthetic paper materials as well as cellulosic paper materials. Therefore, the rejections over Erickson are maintained.

10. The Applicant also argues that Lamb, Sr. would fail to produce the texturized fibrous product comprising "internal fibers" which are "substantially exposed," (Response, pages 3 – 4). Further, the Applicant submitted a Declaration which stated that the process disclosed by Lamb, Sr. would not produce the "texturized fibrous product" recite in claim 1 since a further step is required to grind the paper and then shear it into the "texturized" product. The declaration is not sufficient to overcome the rejection over Lamb, Sr. since the claim 7 is limited to a fibrous product where the "internal fibers are substantially exposed." Since, as set forth above, this limitations fails to limit the product to a material wherein the individual fibers are separated from the other fibers in the paper and exposed, the fibrous material formed by the process taught by Lamb, Sr. anticipates claim 7. Further, with regards to the arguments that the references fail to

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show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the grinding and shearing steps used to produce the fibrous material) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus, the rejections based on Lamb, Sr. are maintained.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (703) 605-1170. The examiner can normally be reached on Monday - Friday (9:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Jenna-Leigh Befumo  
May 15, 2002



TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700